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In re Application of

LONG

U.S. Application No.: 10/510,647

PCT No.: PCT/US03/10857

Int. Filing Date: 09 April 2003

Priority Date: 10 April 2002

Attorney Docket No.: CM-020

For: VEHICLE DRIVE SYSTEM WITH ENERGY
RECOVERY SYSTEM AND VEHICLE
MOUNTING SAME

DECISION ON PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to the applicant's "Petition Under 37 CFR 3.47 With Declaration And Fees" filed 26 August 2005 in the United States Patent and Trademark Office (USPTO). For the reasons discussed below, the petition is being treated as a petition under 37 CFR 1.47(b) to accept the application without the signature of inventor Thomas Long.

BACKGROUND

On 09 April 2003, applicant filed international application PCT/US03/10857 which claimed priority to an earlier U.S. application filed 10 April 2002. Pursuant to 37 CFR 1.495, the deadline for paying the full, U.S. Basic National Fee was set to expire at midnight on 10 October 2004.

On 08 October 2004, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First preliminary amendment.

On 27 June 2005, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 26 August 2005, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Therefore, a review of the papers provided finds that applicant has satisfied items (1), (3) and (4).

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Presently, applicant has provided a statement from counsel that the "The assignee avers that it has, through its President Michael Fowler, taken and exhausted all diligent efforts to locate and obtain the signature of the inventor on the attached declaration. That the inventor is unavailable at this time." In order to proceed without Mr. Long's signature on the declaration, applicant is required to provide detailed information as to the "diligent effort" such as whether a search of telephone directories or Internet search engines were performed in an attempt to find a current address for the inventor, as well as, the circumstances of his unavailability. As shown, above this information should be provided by an individual with firsthand knowledge of the attempts to locate Mr. Long.

Regarding item (5), applicant's present petition references the inclusion of a copy of the relevant assignment document, however the paper was not included nor does a copy exist in the application file.

As to item (6), applicant states that failure to grant the petition will, "cause extreme hardship to the assignee and the inventor in the loss of patent rights in the above identified application." In order to satisfy item (6), applicant is also required to state that damage caused, i.e. the extreme hardship, would be irreparable.

For the reasons stated above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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